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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,530	01/22/2002	Trevor Martin	124-909	4032
23117	7590	01/10/2005	EXAMINER	
NIXON & VANDERHYE, PC 1100 N GLEBE ROAD 8TH FLOOR ARLINGTON, VA 22201-4714			ANDERSON, MATTHEW A	
			ART UNIT	PAPER NUMBER
			1765	

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/009,530	MARTIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Matthew A. Anderson	1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 02 September 2004.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 6 and 7 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 6 and 7 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a))

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/11/2004.

4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .

**DETAILED ACTION*****Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 9/02/2004 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of

35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claim 6,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goodhue (US 4855255) in further view of Moerman (IEEE Journal of Selected Topics in Quantum Electronics, 3(6), pp. 1308-1320, December 1997.) and further in view of Colas et al. (Applied Physics Letters, 59(16), pp. 2019-2021, 14 October 1991.).

Goodhue discloses tapered laser or waveguide devices made by gradient thermal heating during epitaxial growth of III-V semiconductors such as GaAs and AlGaAs (see abstract). Fig. 9 details an example with MBE (molecular beam epitaxy). CBE (chemical beam epitaxy) is disclosed in col. 10 lines 50-53 as an alternative method of deposition.

Goodhue does not disclose the use of a mechanical mask to form the tapered layer.

Moerman et al. discloses the known fabrication technology used to form tapers in III-V semiconductor devices. Fig. 7 and the last paragraph in col. 1 describe the mechanical shadow masked growth (SMG) technique by which an easily removable monocrystalline Si mask is placed over the substrate and both tapered and un-tapered layers are grown in a single step (see especially Fig. 7 (f)). The SMG method is described as preferable to the SAG method in that SAG method uses selective growth by the direct application of SiO<sub>2</sub> masks (see Fig. 7

(d)) on the structure. The SMG allows avoiding selective deposition and allows quality film formation.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to combine the descriptions of Goodhue and Moerman because Moerman describes the mechanical mask as easily removed after the growth thus simplifying the process.

This combination does not explicitly describe the mechanical shadow mask as having a oxide film coating on which deposition is retarded at the process conditions.

Colas et al. discloses that it was known to effect the local growth rate by choosing the pattern of dielectric (e.g.  $\text{SiO}_2$ ) masked layers during selective area growth of III-V semiconductors.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to combine the oxide layer with the mechanical SMG method and form a oxide coated Si mask shadow mask because this would prevent contamination from superfluous deposited material on the mask and thus improve uniformity from run to run. Moerman et al. suggests oxide masks for retarding epitaxial growth forming tapers.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to grow a tapered epitaxial layer by CBE upon a substrate by using a mechanical shadow mask because such is suggested by the combined disclosures.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to grow both tapered and un-tapered portions of the epitaxial layer because such is clearly suggested by Fig. 7(f) of Moerman et al.

It would have been obvious to one of ordinary skill in the art at the time of the present invention to fabricate a waveguide device in the manner claimed because waveguide fabrication is suggested by Moerman in the abstract .

Thus, it would have been obvious to one of ordinary skill in the art at the time of the present invention to use etched Si wafers (as per Moerman et al.) with an oxide mask to prevent deposition on the mask.

### ***Response to Arguments***

5. Applicant's arguments filed 9/02/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of the easily removable mask of Moermann leads one to the motivation of a simplified process. The use of a coating to retard epitaxial growth was described by Colas et al. Moerman

describes retarded epitaxial growth obtained by oxide masks when forming tapered layer.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Goodhue suggests tapered layer formation with CBE. Moerman discloses that such tapered layer deposition be achieved using a mechanical shadow masks. Colas discloses dielectric (e.g. SiO<sub>2</sub>) masks and suggests that these masks effect the deposition rate. Moerman states that no growth occurs with a dielectric mask in MOVPE tapered growth. Goodhue suggests that CBE and MOVPE (aka. MOCVD) are interchangeable methods in col. 10 lines 50-55. The examiner notes that the claims do not exclude the use of the temperature gradients of Goodhue et al.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the ability to grow think highly planar tapers epitaxially) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew A. Anderson whose telephone number is (571) 272-1459. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on (571) 272-1465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MAA  
January 6, 2005

NADINE G. NORTON  
SUPERVISORY PATENT EXAMINER  
